

REMARKS

In the Office Action mailed February 22, 2006, the Examiner made final the restriction requirement set forth in the Office communication dated October 6, 2005, and confirmed applicants' election of the claims of the Examiner's Group I, Claims 1-51, for prosecution in the present application. In addition, the Examiner confirmed the applicants' designation of the species 1-{3-[(6-amino-5-nitropyridin-2-yl)amino]propyl}-4-(2,4-dichlorophenyl)-N-[(1S)-2-hydroxy-1-methylethyl]-1H-pyrrole-3-carboxamide (as disclosed in Example 7) for initial search and examination purposes.

Objection to Claims 1-51

The Examiner has objected to Claims 1-51 for containing non-elected subject matter. This objection is respectfully traversed.

The Examiner has made only one restriction requirement in the present application, as set forth in the Office communication dated October 6, 2005, as follows:

For these reasons provided below, restriction to one of the following Groups is required under 35 U.S.C.121, wherein a Group is a set of patentable distinct inventions of a broad statutory category (e.g. compounds, methods of use, methods of making, etc.):

I. Claims 1-51 and 65 are drawn to products of Formula I, depicted in claim 1, variously classified in classes 544, 546, 548 and several subclasses.

II. Claims 52-64 and 66-69 are directed to methods of use of compounds of Formula I, variously classified in class 514 and several subclasses.

In addition, the Examiner entered a requirement for designation of an individual species for initial search and examination, as follows:

Where an election of group I-II is made, an election of a single compound is further required including an exact definition of each substitution of the base

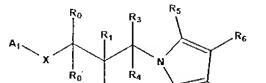
LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206 682 8100

molecule (Formula (I)), wherein a single member at each substituent group or moiety is selected.

In response to the Examiner's restriction requirement, the applicants elected the claims of the Examiner's Group I (Claims 1-51 and 65), and cancelled Claim 65. In response to the Examiner's designation of species requirement, the applicants designated the species 1-[3-[(6-amino-5-nitropyridin-2-yl)amino]propyl]-4-(2,4-dichlorophenyl)-N-[(1S)-2-hydroxy-1-methyl-ethyl]-1H-pyrrole-3-carboxamide (as disclosed in Example 7).

The Examiner now is apparently seeking to impose a further restriction requirement (without so stating) by a mischaracterization of the invention that applicants have elected for prosecution in the present application in response to the prior restriction requirement. As stated by the Examiner:

The scope of the invention of the elected subject matter and examined is:



Compounds of formula (I), , wherein: X is Nitrogen; W is selected from the group consisting of -CONH, -CO, -CO₂, NHCO and NRCO; A₁ is an optionally substituted six-membered heterocyclic group with one N; R₁-R₈, are as defined except that they don't represent a heterocyclic group.

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 1-51 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b) as being drawn to non-elected inventions. . . .

However, the applicants have made no such election. Rather, the applicants have simply elected the subject matter of the Examiner's Group I (Claims 1-51) as written for prosecution in this application, and 37 C.F.R. 1.142(b) provides no basis for the Examiner's apparently arbitrary reduction in the scope of applicants' claims.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206 682 8100

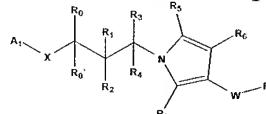
37 C.F.R. 1.142(b) provides as follows:

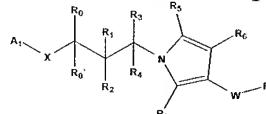
§ 1.142 Requirement for restriction. . . .

(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

Thus, 37 C.F.R. 1.142(b) provides a basis for the withdrawal from further consideration by the Examiner of whole claims directed to non-elected inventions. However, it provides no basis whatsoever for withdrawal from further consideration of bits and pieces of claim language, at the discretion of the Examiner, to arrive at phantom claim language of reduced scope crafted by the Examiner.

In an attempt to justify reducing the scope of applicants' claims, the Examiner has stated, "This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 180+ (triazine), class 546 subclass 249(+) (pyridines), class 548 subclass 215(+) (triazoles), 548 subclass 400(+) pyrrolidines etc." However, applicants' invention is directed to a new family of



compounds, represented as , defined by the common core pyrrole chemical backbone structure and side chains, that have a common GSK3 inhibitory activity based upon the defined structure of the family.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206 682 8100

Conclusion

Entry of the foregoing amendments is requested. The Examiner is further requested to contact applicants' representative at the number set forth below to resolve any issues that may facilitate prosecution of this application.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Dennis K. Shelton
Registration No. 26,997
Direct Dial No. 206.695.1718

DKS:cj

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206 682 8100